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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,668	08/05/2003	Nobuyuki Motoki	S0529.0003	5313
32172	7590	08/09/2005	EXAMINER	
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP 1177 AVENUE OF THE AMÉRICAS (6TH AVENUE) 41 ST FL. NEW YORK, NY 10036-2714			LEUBECKER, JOHN P	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/633,668	MOTOKI ET AL.	
	Examiner	Art Unit	
	John P. Leubecker	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 25 May 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
 - 4a) Of the above claim(s) 12-16 and 18-20 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-11, 17, 21 and 22 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/18/03</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

Election/Restrictions

1. Applicant's election with traverse of Group I in the reply filed on May 25, 2005 is acknowledged. The traversal is on the ground(s) that the inventions are related and thus not restrictable. This is not found persuasive because, by Applicant's reasoning, all ten thousand inventions (patents) that currently exist and describe endoscope apparatuses would be considered "related" and examinable in a single application. This is not reasonable. As explained in the previous Office Action, each Group pertains to a different aspect of an endoscope apparatus and thus each *invention* is unrelated to each other.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 12-16 and 20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Specification

3. The abstract of the disclosure is objected to because it should not begin with "The present invention...". Correction is required. See MPEP § 608.01(b).

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

5. The disclosure is objected to because of the following informalities: the description of Figures 47 and 48 on pages 1-4 of the specification refer to reference numbers that are not shown in Figures 47 and 48. These should be corrected in the specification or, alternatively, corrected in Figures 47 and 48.

Appropriate correction is required.

Claim Objections

6. Claims 1 and 9 are objected to because of the following informalities:

a) in claim 1, the term “input device” is described as having an elongated insert portion yet the specification describes the input device as “remote controller” (page 25, line 16) which does not include an elongated insert portion (this is part of the scope). Appropriate correction is required. Furthermore, second occurrence of “an elongated” (lines 2-3) needs to be deleted.

b) in claim 9, phrase “an insert portion which inserts a flexibly bending portion” is improper. It appears that the word “inserts” should be –includes--.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1, 5, 17, 21 and 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 1, recitation that the linking portion “detachably links between a peripheral portion at the proximal opening end *in* the manipulating device inserting channel” is ambiguous since it would appear to be defining an element that links to the *inside* of the channel, which is not disclosed in the specification. It appears that –proximal opening end *of* the manipulating device inserting channel—was intended.

As to claim 5, phrase “in the insert portion” is indefinite since, as described immediately above, the fixing device is not disclosed as linking *in* the insert portion.

As to claim 17, term “input portion” (lines 16-17) lacks antecedent basis. It appears that this should have been “input device”. In addition, phrase “wherein the linking portion disposes the proximal opening end of the manipulating device inserting channel” begs the question: disposes it where?

As to claims 21, terms “connecting portion” and “portion to be mounted” lack antecedent basis. It appears that this claim was intended to be dependent on claim 20.

As to claim 22, term “connection portion” lacks antecedent basis. Term “linking portion” conflicts with previously claimed linking portion (claim 17). It appears that this claim was intended to depend from claim 20.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-6, 8-11 and 17-19 are rejected under 35 U.S.C. 102(a or e) as being anticipated by Mizuno et al. (U.S. Pat. 6,569,084).

Referring mainly to Figure 1, Mizuno et al. disclose an elongated flexible insert portion (2), a flexibly bending operation portion (27), a flexibly bending portion (3), a manipulating device inserting channel (9), and a linking portion (25) which links between the proximal opening of the inserting channel (9) and the “input device” which is any of the first three elements mentioned above (note Fig. 1). Unless the operation portion (e.g., joystick 27) is located immediately adjacent and covering the proximal opening of the inserting channel (9) (and the Examiner did not find any references showing this—and didn’t expect to), the operation portion when operated will never “interfere” with insertion of an instrument into the inserting channel. This is the case shown in Figure 1. As shown in Figures 1 and 9, the linking portion (25) is disposed on a side face of grip (26) which includes the operation portion (27). The linking portion (25) is fixed to the input device (note first three elements described above) and the periphery of the inserting channel (9) at an arbitrary axial position. As shown in Figure 10, the joystick (27) generates a signal corresponding to a tilt. Regarding claim 9, “rod portion operation” is being interpreted as movement of the operation portion (e.g., movement of the joystick). Furthermore, the connecting device is met by the structure described above with

respect to the linking portion. As to claim 17, most elements are described above. The intermediate linking portion is met by manipulation portion (5) of the endoscope. Also note universal cable (7).

11. Claims 1-5, 7, 9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Costella (U.S. Pat. 4,696,544).

Costella discloses an input device (8) which has an elongated insert portion (12) having flexibility, a flexibly bending portion (distal end of 12), a flexibly bending operation portion (18), a manipulating device inserting channel (channel within insertion tube 20) which communicates between the distal and proximal ends of the insert portion (Fig.1), and a linking portion (10,22) which detachably (col.5, line 61 to col.6, line 8) links between a peripheral portion at the proximal opening end of the insertion channel (note end of channel within 20 at proximal end of 22a) and the input device (col.5, lines 32-38). Inherently, the proximal end opening (at proximal end of 22a) does not interfere with operation of the flexibly bending operation portion (18) (note Figure 1). The linking portion is fixed to a side face different from the operation portion (18) (note position of (10) with respect to portion (18)). As to claim 7, the channel (within tube 20) is exterior to the insert portion (12). As to claim 9, the connecting device is the structure which mounts the a flexibly bending operation portion (18) to the fiberscope body (8) (inherently the knob 18 is mounted to body 8). Operation of the knob (18) does not overlap the channel within tube (20) (inserting channel).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Because of the overly broad claims, only a portion of the prior art that was found to be relevant to Applicant's claims will be cited now.

Banik et al. (2005/0119527) Siegmund (U.S. Pat. 4,919,112)

Oneda et al. (U.S. Pat. 5,447,148) Goto et al. (U.S. Pat. 2004/00150050)

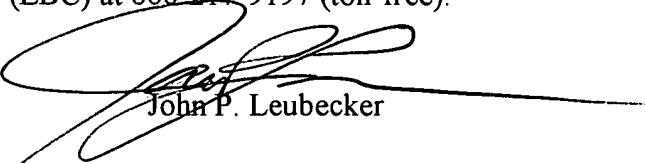
Matsuo et al. (U.S. Pat. 4,489,728) Yabe et al. (U.S. Pat. 5,431,150)

Matsui et al. (U.S. Pat. 6,352,503) Maedo et al. (U.S. Pat. 6,554,766)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (571) 272-4769. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P. Leubecker

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Primary Examiner
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jpl